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No. 88-308

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM 1988

JAMES CONSTANT,

Petitioner,

v.

ADVANCED MICRO-DEVICES, INC., GOULD, INC., AMERICAN MICROSYSTEMS, INC., ANALOG DEVICES, INC., FUJITSU, LTD., FUJITSU MICROELECTRONICS, INC., DIGITAL SWITCH, INC., GRANGER ASSOCIATES, INC., HITACHI CORPORATION, INTEL, INC., INTERACTIVE CIRCUITS & SYS. LTD., MATSHUSHITA ELECTRONICS CORP., COMPUTER MODULES, INC., NIPPON ELECTRIC CO., LTD., NEC ELECTRONICS USA, PARADYNE CORPORATION, SEMICONDUCTOR PRODUCTS, TEXAS INSTRUMENTS, INC., and TRW, INC.

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR RESPONDENTS IN OPPOSITION

KRISTIN M. CANO
One Newport Place, Suite 550
Newport Beach, California 92660
(714) 476-9868

KANE, DALSIMER, SULLIVAN, KURUCZ, LEVY, EISELE and RICHARD
711 Third Avenue
New York, New York 10017
(212) 687-6000

Attorneys for Respondent Paradyne Corporation Submitted on Behalf of All Respondents.

QUESTIONS PRESENTED FOR REVIEW

Paradyne Corporation, speaking on behalf of all respondents (hereinafter, collectively referred to as "Paradyne"), presents this statement of the Questions Presented for Review because Paradyne disagrees that Petitioner, James Constant, ("Petitioner" or "Constant") has accurately framed the questions presented in the Petition for Certiorari ("Petition"). Accordingly, Paradyne provides the following statement of Questions Presented for Review:

1. Whether the United States Court of Appeals for the Federal Circuit ("the Federal Circuit") improperly decided that 35 U.S.C. Section 282, which permits the federal courts to adjudicate the validity of patents when invalidity is raised as an affirmative defense in an infringement action was constitutional and, that the congressional creation of the Patent and Trademark Office reexamination procedure did not divest the courts of the power to review patent validity.

2. Whether the United States District Court for the Central District of California abused its Discretion in its taxation of costs against Constant and whether such taxation of costs by the district court in a civil action comes within the excessive fines clause and constitutes cruel and unusual punishment pursuant to the Eighth Amendment and a denial of due process pursuant to the Fifth Amendment to the Constitution.

3. Whether the Judgement of the Federal Circuit holding the two patents in suit invalid was proper.

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STATEMENT OF RELATED CASES

United States Court of Appeals for the Federal Circuit:

No. 88-1414
James Constant v. *Advanced Micro-Devices, Inc., et al.*

No. 88-1196
James Constant v. *Robert Hillman*

No. 88-1198
James Constant v. *Marcian Hoff, et al.*

No. 88-1197
James Constant v. *Hitachi America, Ltd., et al.*

No. 88-1195
James Constant v. *Stephen Wilson; Robert Hillman*

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OPINION BELOW

The opinion of the United States Court of Appeals for the Federal Circuit is reported at *Constant* v. *Advanced Micro-Devices, Inc.*, 848 F.2d 1560 (1988).

JURISDICTION

The Judgment of the court of appeals was entered on June 9, 1988 (Pet. App. A2-A3). A petition for rehearing was denied on July 8, 1988 (Pet. App. A63-A64). The petition for a writ of certiorari was filed on August 18, 1988. The jurisdiction of this Court is invoked under 28 U.S.C. Section 1254(1).

STATEMENT OF THE CASE

Constant has used the "Statement of the Case" to set before the Court's consideration innaccurate, erroneous, unsupported and irrelevant matters. To obviate any confusion, Paradyne provides a more complete statement of the background of this case relevant to the Petition before the Court.

In January, 1985, Constant filed a ten-count Complaint against seventeen defendants[1] alleging infringement of his United States Patent Nos. 3,950,635 (the "'635 patent") and 4,438,491 (the "'491 patent"). The Complaint also contained nine non-patent counts including challenges to the constitutionality of 35 U.S.C. Section 282 and federal funding of research and development. Upon motion of the Respondents, the district court (Honorable Pamela A. Rymer) dismissed all counts with the exception of the Count V alleging infringement of the patents in suit. The District Court later entertained and denied several motions by Constant attempting to revive the dismissed counts.

Respondents then filed counterclaims for declaratory relief pursuant to 35 U.S.C. Section 282, seeking to have the patents declared invalid, unenforceable and non-infringed. Respondents then filed motions for summary judgment on their counterclaims and plaintiff, in turn, filed motions for summary judgment on the issue of infringement. Thereafter, the case was transferred to the Honorable Steven V. Wilson for further proceedings.

With the agreement of all parties, Judge Wilson, in August, 1986 appointed a Special Master, Robert E. Hillman, to make recommendations to the court on issues of patent validity and infringement or non-infringement. Pursuant to the Order of Reference, the Special Master thereafter submitted his recommendations to the District Court, concluding that the patents are invalid. Only after the recommendation of invalidity was made to the District Court did Constant move to disqualify the Special

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1. All of the facts concerning the underlying action are set forth in detail in the Federal Circuit opinion in *Constant* v. *Advanced Micro-Devices, Inc. etc. et.al.*, 848 F.2d 862 (Fed.Cir. 1988).

Master and strike his reports. The court ruled against Petitioners Motions to Disqualify and Strike, after hearings in which Constant was given the opportunity to question and examine the Special Master. The District Court then independently determined that there were no material issues of contested facts and accordingly entered summary judgment declaring the claims of the '495 and '635 Patents to be invalid under 35 U.S.C. Section 102(b) and 35 U.S.C. Section 103.

Thereafter, on or about December 12, 1987, Constant filed his appeal in the United States Court of Appeals for the Federal Circuit, *Constant* v. *Advanced Micro Devices, Inc. etc. et. al.*, Case No. 88-1101. On June 9, 1988, the United States Court of Appeals for the Federal Circuit affirmed the rulings of the district court in all respects.

Following the entry in judgment by the District Court, on November 24, 1987, Respondents requested the Clerk of the Court to tax the costs set forth in the Bill of Cost that they filed jointly. On March 28, 1988, the Clerk of the Court taxed costs against Constant in the amount of $29,320 for deposition costs, reproduction of exhibits, court-ordered service of plaintiff's pleadings and patent file materials. The Clerk however disallowed costs for the fees defendants paid to Special Master Robert Hillman, in the amount of $85,598.51 and also disallowed special reproduction costs in the amount of $9691.20 due to a policy of the Clerk's office to leave taxation of such costs to the District Court.

On April 1, 1988, Respondents moved the District Court to retax the fees of the special master and the reproduction costs to Mr. Constant. Concurrently, Constant moved the district court to dismiss determination of costs, disallow costs and impose sanctions against defendants. At the hearing on May 2, 1988, the District Court granted Respondents' motion to retax costs and denied Constant's motion. The District Court ordered that the costs, totalling $123,832 be entered into and made part of the judgment entered in favor of Respondents. This order granting Respondents' Motion to Retax costs was entered on May 10, 1988

and is the subject of a separate appeal still pending before the Federal Circuit and not properly before this Court.[2]

SUMMARY OF ARGUMENT

The Federal Circuit properly determined the constitutionality of 35 U.S.C. Section 282 which permits the courts to adjudicate validity of patents when invalidity is raised as an affirmative defense in an infringement suit. While noting that judicial review of patents was accepted by the framers of the Constitution and Congress in the adoption of the first Patent Act in 1790, the Federal Circuit concluded that Congress was fully within its constitutional power when it delegated to the courts, in 35 U.S.C. Section 282, the power to determine validity in an action for patent infringement.

The Federal Circuit also properly determined that the *ex parte* reexamination procedure of the PTO did not divest the courts of the power to review patent validity and that such procedure was merely created by Congress as an additional mechanism to be used in the review of patents. Reexamination proceedings were never statutorily contemplated to replace judicial determinations of validity because they are limited in scope to printed prior art and not designed to consider all matters relating to validity such as prior offer for sale, which was most relevant in determining one of Petitioner's patents invalid.

The issue of whether the district court abused its discretion in its taxation of costs against Constant is not properly before this Court since, Constant has filed a separate appeal in the Federal Circuit (88-1414), which is still pending, on the issue of taxation of costs. The taxation of costs in a civil matter does not come within the excessive fines clause of the Eighth Amendment since the taxation of costs in a civil matter is not punitive in nature. The taxation of costs in a civil matter does not come within the

2. The taxing of costs was the subject of a separate appeal filed in the United States Court of Appeals for the Federal Circuit, *Constant* v. *Advance Micro-Devices, Inc., etc. et.al.*, Case No. 88-1414. No judgment on Case No. 88-1414 has been rendered by the Federal Circuit as of the date of filing the brief herein.

Eighth Amendment proscription against cruel and unusual punishment since this Eighth Amendment proscription only applies to one convicted of a crime and not to a civil litigant plaintiff who voluntarily seeks to litigate in the courts of the United States.

Constant's last issue is the only issue properly before this Court: were the summary judgments on the '635 and the '491 Patents improper. Constant's sole argument for granting his Petition is the purported refusal by the lower courts to follow *Graham* v. *John Deere & Co.*, 383 U.S. 1 (1966). This argument is totally frivolous and lacks merit, in that, the lower courts repeatedly cited, paraphrased and applied *Graham, supra,* in adjudicating the invalidity of Constant's patents.

ARGUMENT

I. THE FEDERAL CIRCUIT PROPERLY DECIDED THAT 35 U.S.C. SECTION 282 PERMITS THE FEDERAL COURTS TO ADJUDICATE THE VALIDITY OF PATENTS WHEN INVALIDITY IS RAISED AS AN AFFIRMATIVE DEFENSE IN AN INFRINGEMENT ACTION AND THAT THE CONGRESSIONAL CREATION OF THE PATENT AND TRADEMARK OFFICE REEXAMINATION PROCEDURE DID NOT DIVEST THE COURTS OF THE POWER TO REVIEW PATENT VALIDITY.

A. The District Court had Jurisdiction to Determine Validity.

Petitioner raises a red herring in suggesting that it was a denial of due process for the federal courts not to defer to the reexamination of Petitioner's patents by the Patent and Trademark Office ("PTO").

The Federal Circuit in reviewing Constant's challenge to the constitutionality of 35 U.S.C. Section 282, correctly determined that in interpreting the Patent and Copyright Clause of the Constitution, U.S. Const. Art.I Section 8, cl.8, the courts of the United States have "consistently construed the Patent and Copyright Clause to permit judicial review of patents." 848 F.2d at

1564. Congress has acted properly in enacting Section 282 which permits judicial review in an infringement action. The Federal Circuit further stated:

> Public policy requires that only inventions which fully meet the statutory standard are entitled to patents. This policy is furthered when the validity of a patent, which was originally obtained in *ex parte* proceedings in the PTO, can be challenged in court. *Lear, Inc.* v. *Adkins*, 395 U.S. 653, 670, 162 USPQ1, 8 (1969).
>
> "Within the limits of the constitutional grant, the Congress may . . . implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim." *Graham*, 383 U.S. at 6, 148 USPQ at 462 . . . . Thus Congress has broad discretion on how to implement the conditions and tests for patentability. *Id.; McClurg* v. *Kingsland*, 42 U.S. (1 How.) 202, 206 (1843). Nowhere does the Constitution require that the determination of patent validity be vested solely in the PTO (or even that there be a PTO). Congress was fully within its constitutional power when it delegated power to the courts in 35 U.S.C. Section 282 to adjudicate the validity of patents in infringement suits.[3] Congress was also within its constitutional powers when it created a reexamination procedure as an additional mechanism for the review of patents.

848 F.2d 1564.

Thus the Federal Circuit properly determined that the district court had jurisdiction to review the validity of the Petitioner's patents.

B. Patent Office Reexamination Proceedings are Limited in Scope and Could not have Considered the Evidence that Contributed to a Finding of Invalidity in the District Court.

Plaintiff's attempt to confuse the issues in this case are transparent at best, since to divest the district court of its jurisdiction in favor of PTO reexamination would eliminate the bases for determination of invalidity in this action because PTO Reexamination

cannot consider the grounds used in the district court to invalidate one of Petitioner's patents: prior offer for sale under 35 U.S.C. Section 102(b).

Reexamination proceedings are limited to consideration of patentability over printed prior art, such as articles and patents. 35 U.S.C. Section 301. The Patent Examiner cannot consider unprinted prior art, such as prior devices or known products or techniques (Section 2258 of the *Manual of Patent Examining Procedure* (5th ed. 1983, rev. 1987). See also, 37 C.F.R. 1.552, and *In re Lanham*, 1 USPQ 2d 1877 (Com. Pat. 1986) where it is stated:

> Congress was aware when it passed the reexamination statute that the term 'prior art' encompassed more than patents and printed publications; *its intent was to have reexamination based solely on patents and printed publications.*

1 USPQ 2d at 1878. (Emphasis added).

This limitation of reexamination proceedings is significant because evidence that invalidating prior art devices were known and used in this country more than one year prior to the date of application for the patent in suit and before the alleged invention cannot be considered by the PTO and can only be considered in a district court proceeding.

Moreover, the Patent Examiner cannot, under reexamination regulations, consider whether or not Constant acted improperly during the original application for the patent. 37 C.F.R. Sections 1.552 and 1.555; *In re Lanham*, 1 USPQ 2d 1877 (Comm. Pat. 1986) (issues of fraud and inequitable conduct "not properly for consideration during reexamination"). Thus, even if the Patent Office could consider the validity of the patent over prior uses and knowledge, it could not consider whether other activities should render the patent unenforceable.

The Patent Examiner also cannot address the issue of whether or not arguments made by Constant during the prosecution of its original application resulting in the patent limit the scope of the claims ("file wrapper estoppel").

Reexamination proceedings are *ex parte* and one sided, and were designed to be so after the Patent Office's experience with inter partes proceedings. In 1977, the PTO adopted amendments to the Patent Office Rules wherein patent owners could file applications to reissue their patents and, in the process, cite prior art to the PTO. The public, under these rules was notified of the reissue application filed, and the public, including defendants who had been sued by the patent owner, were permitted to contest the reissue by participating with, for example, briefs, depositions transcripts, copies of documents obtained in discovery, and affidavits of experts and witnesses. Under these rules, it was not unusual in such contested re-issue proceedings for the PTO to conclude that the patent owner did not have a patentable invention.

In 1981, the PTO decided to stop the contested reissue proceedings since too much PTO time and resources were being consumed and the courts were more properly the place for such inter partes proceedings and the inter partes rules were repealed. In their place, pursuant to 35 U.S.C. Sections 302-07, the PTO instituted the far more limited, *ex parte* reexamination of patents. The PTO rules and procedures for reexamination repeatedly make clear that reexamination is intended to be, and will be, an *ex parte* proceeding (*Manual of Patent Examining Procedure,* sections 2209 and 2254).

Thus, it is disingenuous for Petitioner to suggest that district court determination of validity denies him full trial and due process when the reexamination procedure is an *ex parte* procedure not designed to determine all issues relating to validity.

Pursuant to 35 U.S.C. 302, any person may, at any time, file a request for reexamination; however, Mr. Constant has never requested reexamination of his patents. Mr. Constant has made a bold faced attempt to mislead this Court in claiming that he recommended reexamination in the courts below. (Petitioner's Brief at p.3.) Petitioner could have requested reexamination of his patents before he filed this action or even after he filed, but he did not: he voluntarily chose the federal courts to litigate his

patents and cannot now complain that Petitioners' exercise of their statutory rights, pursuant to 35 U.S.C. Section 282, in defense of the action he filed, in a forum chosen by him, is a denial of his due process rights.

II. THE DISTRICT COURT DID NOT ABUSE ITS DISCRETION IN ITS TAXATION OF COSTS AND SUCH TAXATION OF COSTS BY THE DISTRICT COURT IN A CIVIL ACTION DOES NOT CONSTITUTE AN EXCESSIVE FINE NOR CRUEL AND UNUSUAL PUNISHMENT PURSUANT TO THE EIGHTH AMENDMENT AND A DENIAL OF DUE PROCESS PURSUANT TO THE FIFTH AMENDMENT TO THE CONSTITUTION.

A. The Taxation of Costs in the District Court is not properly before this Court since it is still Pending before the Federal Circuit.

After judgment was entered by the district court on November 24, 1988, Constant filed two separate appeals: the first Federal Circuit No. 1101 which is the subject of Constant's Petition before this Court; and, the second, Federal Circuit No. 1414 which was an appeal from the district court's taxation of costs in the amount of $123,832 and the concurrent entry into and modification of the November 24, 1988 judgment. Judgment was entered in Federal Circuit No. 1101 on June 9, 1988; however, Federal Circuit No. 1414 is still pending. Accordingly, Constant's Petition as directed to the issue of costs taxed by the district court is not properly before this Court. Furthermore, Mr. Constant cannot now complain that the district court abused its discretion in the taxation of costs in light of the "low cost procedure for reexamination in the Patent Office under 35 U.S.C. 302 *et seq.*" (Pet. Br. at 9) when Mr. Constant, at no time sought reexamination, but did, in fact, choose to litigate in the courts of the United States.

B. The Taxation of Costs in a Civil Action does not come within the Purview of the Excessive Fines Clause of the Eighth Amendment nor does it Constitute Cruel and Unusual Punishment.

The Eighth Amendment has no application whatsoever to the taxation of costs in a civil action since the proscriptions of the Eighth Amendment apply only to those convicted of a crime and not to a civil litigant such as Mr. Constant who voluntarily chose to litigate his patents in the civil courts of the United States. *Ingraham* v. *Wright*, 430 U.S. 651 (1977); *Revere* v. *Massachusetts General Hospital*, 463 U.S. 239 (1983); *Palermo* v. *Rorex*, 806 F.2d 1266 (5th Cir. 1987). While due process protects rights of citizens who have not been convicted of crimes, the Eighth Amendment is applicable only to sentenced criminals. *Bailey* v. *Andrew*, 811 F.2d 366 (7th Cir. 1987). Further, while the applicability of the Excessive Fines Clause to civil punitive damages is "a question of some moment and difficulty" *Bankers Life & Casualty Co.* v. *Crenshaw*, 486 U.S. , 108 S. Ct. 1645, 1651 (1988) the taxation of costs in civil actions pursuant to 28 U.S.C. Section 1920 is not punitive in nature.

C. There has been no Abuse of Discretion in the Appointment of the Special Master

Mr. Constant failed to object to Mr. Hillman when he was appointed as Special Master to advise the court on the issues raised in the Summary Judgment motions in August of 1986. Constant only objected to Mr. Hillman and his report after Mr. Hillman indicated that both patents were invalid in January and February, 1987 (848 F.2d at 1563). Constant's attack on Mr. Hillman is nothing more than a losing litigant's "sour grapes."

The appointment of a Special Master is lodged in the sound discretion of the trial court. *Crateo, Inc.* v. *Intermark, Inc.*, 535 F.2d 862, 868 (9th Cir. 1976); *Macri* v. *United States*, 353 F.2d 804, 809 (9th Cir. 1965). Constant consented to the Special Master and has failed to demonstrate any abuse of discretion whatsoever in the appointment of Mr. Hillman.

III. NO REASONS ARE RAISED BY CONSTANT ABOUT WHY A WRIT OF CERTIORARI SHOULD BE GRANTED TO REVIEW THE FEDERAL CIRCUIT'S AFFIRMANCE OF THE DISTRICT COURT'S JUDGMENT OF PATENT INVALIDITY

Constant's last issue addresses the only issue properly before this Court: Were the summary judgments on the '635 and '491 patents improper. Constant's sole argument for granting his petition is the lower courts' purported refusal to follow an earlier decision of this Court—a decision that those courts repeatedly cited, paraphrased and applied. Thus, Constant's petition merely reiterates what the Federal Circuit labelled as virtually frivolous arguments. *Constant*, 848 F.2d at 1570.[3]

Constant premises his challenge to the decisions below upon the purported failure of the lower courts to make the factual inquiries on the issue of obviousness[4] enumerated in *Graham* v. *John Deere & Co.*, 383 U.S. 1 (1966).[5] (Pet. for Certiorari at 12). However, *Graham* provides no reason for this Court to devote its finite resources to this case.

Clearly, the Federal Circuit's analysis of *Graham* does not conflict with the decision of any other circuit court or any other

3. The Federal Circuit devoted special attention in both the opening *and* the closing of its opinion about the frivolity of Constant's appeal. That court stated "[b]ecause of appellant's earnest efforts to support his positions, we deal with them in greater detail than their merits deserve." 848 F.2d at 1563. In closing, the court stated:

> The district court went to great lengths to be fair and has shown great patience in the face of arguments and tactics that would have been improper if advanced by a lawyer. . . . Appellant is hereby cautioned that if he persists by trying to raise again the same issues that have been finally decided by the district court or by this court, he could be sanctioned. . . . *id.* at 1572.

4. Section 103 provides that "[a] patent may not be obtained . . . if the differences between the [claims] and the prior art are such that the subject matter as a whole would have been obvious. . . ."

5. In *Graham, supra*, this Court interpreted Section 103 of the Patent Act to require a four part test comprised of: (i) the scope and content of the prior art; (ii) differences between the prior art and the claims; (iii) the level of ordinary skill in the art; and (iv) secondary indicia of nonobviousness such as the commercial success of the invention. *Id.* at 17.

court. Since 1982, all appeals in patent cases have been lodged in the Federal Circuit to "'reduce the widespread lack of uniformity . . . in . . . patent law.'" *Christianson* v. *Colt Industries Operating Corp.*, 486 U.S. , 108 S. Ct. 2166, 100 L.Ed. 2d 811, 828 (1988). Thus, conflicts are unlikely with one court having particular legal expertise in patents lodged with exclusive jurisdiction.

Nor is this a case where the lower courts' decisions conflict with the applicable holdings of this court. This Court's *Graham* decision is inapposite to many of the conclusions on invalidity made below. Numerous claims[6] were found to be invalid below due to a lack of novelty under 35 U.S.C. Section 102(b);[7,8] thus, for those claims, the courts below never addressed the obviousness of those claims under 35 U.S.C. Section 103.

Graham, however, only sets forth the standards for determining validity under Section 103. The *Graham* court carefully noted that Section 102 governed the issue of novelty and refrained from addressing that issue. *Graham,* 383 U.S. at 13.[9] Thus,

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6. The patent owner's invention, and therefore its right to exclude the defendant from making, using and selling the accused device under 35 U.S.C. Section 154, is defined by the claims. An analogy exists between the claims of a patent and the legal description of the property in a deed. The claims describe the intellectual property of the patent owner while the legal description in the deed describes the landowner's real estate. See *In re Vamco,* 752 F.2d. 1564, 1577 n.5 (Fed. Cir. 1985). Using this analogy, infringement (the making, using or selling the claimed invention) is similar to the tort of trespass while patent invalidity is analogous to a defect in the title of real property.

7. Section 102(b) provides that "[a] person shall be entitled to a patent unless . . . (b) the invention was . . .described in a printed publication in this or a foreign country or . . . on sale in this country more than one year prior to the date of the application for patent in the United States . . ." 35 U.S.C. Section 102(b). Although the term new appears in Section 101 of the Patent Act in the context of defining what is patentable, Section 102(b), defines what, for the purposes of patent law, is old, and therefore, unpatentable. See *Titanium Metals Corp. of America* v. *Banner,* 778 F.2d 775, 781 (Fed. Cir. 1985).

8. The district court held and the Federal Circuit affirmed that claims 1, 2, 6-9, and 11-14 of the '635 Patent and claims 1, 7, 8, 9, 16, 18, 21, 22 and 23 of the '491 Patent were not new under 35 U.S.C. Section 102(b). *See Constant,* 848 F.2d at 1568, 1570.

9. See also *Lewmar Marine, Inc.* v. *Barient, Inc.*, 827 F.2d 744, 747-48 (Fed. Cir. 1987) (explaining the historical evolution of the separation of the

Graham is irrelevant to the lower court's determination of patent invalidity on many of the claims. Therefore, even assuming *arguendo* that the courts below failed to follow *Graham*, that failure would have no effect on the soundness of substantial portions of the opinions below.

Even for those remaining claims that were held to be obvious, Constant does not and cannot demonstrate any issue meriting this Court's use of its limited resources. Although Constant claims the courts below failed to follow *Graham* that is simply false. The district court below referred to and paraphrased *Graham* in both of its invalidity opinions. (*See* Conclusion of Law No. 7 on the '635 Patent, Pet. App. at B31); Conclusion No. 1 on the '491 Patent (incorporating by reference Conclusions Nos. 1-9 on the '635 Patent), Pet. App. at B58. The Federal Circuit noted that the district court had properly considered *Graham*. *Constant*, 848 F.2d at 1569.

Even a cursory examination of the district court's decisions demonstrates a religious devotion to the four factor *Graham* test. First, the district court carefully determined that the publications relied upon by the Respondents below were within the scope and content of the prior art. *See* Findings of Fact Nos. 20-31 on the '635 Patent (Pet. App. at B14-B20); Findings of Fact Nos. 14-32 on the '491 Patent (Pet. App. at B44-B54). Second, the district court carefully noted the difference between the claims and the prior art. *See* Findings of Fact Nos. 19, and 33-40 on the '635 Patent (Pet. App. at B14 and B21-B25); Findings of Fact Nos. 34 and 35 (Pet. App. at B55-B58). Third, the district court determined that there was no issue of fact on the level of skill in the field of the patents. *See* Finding of Fact No. 33 on the '491 Patent (Pet. App. at B 54); Finding of Fact No. 32 on the '635 Patent (Pet. App. at B20). Finally, the lower courts considered the secondary or objective indicia of nonobviousness raised by Constant such as commercial success. See *Constant*, 848 F.2d at

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legal tests for invalidity under sections 102 and 103); *Argus Chemical Corp.* v. *Fibre Glass-Evercoat Co.*, 759 F.2d 10, 14 n.5 (Fed. Cir. 1985) (Miller, J. concurring).

1572 (the "evidence consisted of arguments and conclusory statements"). Thus, the lower courts properly applied the *Graham* tests.

Constant's final argument that this Court should overturn the lower courts decisions due to "clearly erroneous" statements about the technology warrants little comment here. Of course, none of these technical complaints relate to the alleged failure of the lower courts to follow *Graham* or any other reason why this Court should devote its limited energies to this matter.[10]

Further, his other arguments concerning the validity of the '491 Patent are meritless. Although Constant urges that the district court invalidated his '491 Patent because it fails to disclose a computer program (Petition at 16), that is not so. The district court and the Federal Circuit concluded that the prior art did not have to include a computer program to anticipate that patent. *See* Finding of Fact No. 32 on the '491 Patent (Pet. App. at B43); 848 F2d at 1569.[11]

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10. Given the extreme technical nature of the patents (the level of skill in the art on the subject patents was a doctorate in electrical engineering or physics, *See* Finding of Fact No. 32 on the '635 Patent, Pet. App B20-B21). Respondents respectfully submit that there is no need to for this court to delve into these extremely technical issues. Further, it is worth noting that the district court used a Special Master who while being a noted patent attorney also had degrees in physics and mathematics from the Massachusetts Institute of Technology (Finding of Fact No. 6; Pet. App. B5-B6). Similarly, the Federal Circuit has technical advisors on its staff to help that court understand complicated technology and the members of that court are acknowledged experts in patent law.

11. It is clear that Petitioner realized that the technology (i.e. Respondent Intel's 2920 chip and its associated publications) which Respondents relied upon to invalidate the '491 patent was identical to the alleged inventions in the '491 patent. This is shown by Petitioner's first letter to Respondent Intel which was written *prior* to the present lawsuit, which letter charged Intel with infringement of the '491 Patent because of that technology (i.e. the 2920 chip). That letter was cited by the District Court and stated, "Your 2920 Signal Processor infringes Claims 1, 7, 8, 9, 16, 18, and 23, as minimum of my enclosed patent [the '491 Patent]." *Constant* v. *Advanced Micro-Devices*, District Court No. 85-0262 SVW (Bx) at Findings of Fact No. 19, Pet. App. at B46p-B47. This enumeration of specific claims is nearly identical to the claims found anticipated under 35 U.S.C. 102(b). Intel responded to that letter by noting that the 2920 chip and its associated publications pre-dated the '491 Patent, but Constant

Similarly, Constant's closing complaints regarding the prior art publications failure to disclose "semiconductor RAM[12] having $\log_2 n$ lines" deserve short shrift by this Court. Constant argues that his claims should be interpreted to include these purported requirements. Yet, these terms appear nowhere in the claims and his '635 patent states that the memories "'may be any one of a number of types, the exact type to be determined by the application.'" *Constant*, 848 F.2d at 1571 (quoting the '635 patent). If the limitations of the "semiconductor RAM having $\log_2 n$ lines" were read into the claims as Constant demands, the claims would not serve their legal purpose of defining the patented subject matter. *See* 35 U.S.C. Section 112; *Constant*, 848 F.2d at 1571.

In conclusion, Constant's charge that the lower courts failed to follow *Graham* is frivolous. In its short existence, the Federal Circuit has shown its fanatical devotion to *Graham* by citing that case in 115 opinions and be repeatedly admonishing district courts that strayed from *Graham's* teachings. *See, e.g., Jones* v. *Hardy*, 727 F.2d 1524 (Fed. Cir. 1984). Here, the district court and the Federal Circuit cited, paraphrased and properly applied *Graham's* four factor test. Thus, no reason exists for this Court to devote its limited resources to a technically complex and unimportant patent case.

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nevertheless sued Intel in this litigation for infringement of the '491 Patent because of the 2920. As clearly demonstrated in the record, Intel had been developing the 2920 chip for several years prior to the filing date of the '491 Patent, and Intel had sold and described that chip in publications, more than one year prior to the filing date of the '491 Patent, (see Findings of Fact Nos. 14, 16 and 17 for the '491 Patent, Pet. App. B44-B46). Thus the very technology which Petitioner claimed was infringing his patent was on sale and described in publications more than one year prior to the filing date of that patent. Thus, the only issue that ever existed was one of who got there first, that is, anticipation.

12. RAM means random access memory. A memory is a device that is used in computers for storing information in a computer; in random access memories, the information can be stored or reviewed in any order, irrespective of the physical location within the memory. A semiconductor RAM is merely a particular type of RAM.

IV. CONCLUSION

For the reasons set forth below, the Respondents herein submit that a writ of certiorari should not be granted in this case.

Respectfully submitted,

/s/ KRISTIN M. CANO

KRISTIN M. CANO
One Newport Place, Suite 550
Newport Beach, California 92660
(714) 476-9868

JOSEPH C. SULLIVAN
KANE, DALSIMER, SULLIVAN, KURUCZ, LEVY, EISELE and RICHARD
711 Third Avenue
New York, New York 10017
(212) 687-6000

Attorneys for Respondent Paradyne Corporation Submitted on Behalf of All Respondents.

PROOF OF SERVICE BY MAIL

I am a citizen of the United States and a resident of the City of Washington, District of Columbia; I am over the age of eighteen years and not a party to the within action; my business address is: 2021 L Street, N.W., Washington, D.C. 20008.

On September 16, 1988, I served the Brief for Respondents in Opposition in re: "James Constant v. Advanced Micro-Devices" in the Supreme Court of the United States on Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit; on the parties in said action, by placing three copies thereof enclosed in a sealed envelope with postage fully prepaid, in the United States post office mail box at 20th and M Streets, Washington, D.C., addressed as follows:

Mr. James Constant
1603 Danbury Drive
Claremont, California 91711

Edwin H. Taylor, Esq.
James C. Scheller, Jr., Esq.
Blakely, Sokoloff, Taylor
& Zafman
1245 Oakmead Parkway
Suite 101
Sunnyvale, California 94086

Philip P. Berelson, Esq.
Brown & Bain
600 Hansen Way
Suite 100
Palo Alto, California 93406

Paul S. Malingagio, Esq.
Sheppard, Mullin, Richter
& Hampton
333 South Hope Street
48th Floor
Los Angeles, California 90071

Jerry R. Selinger, Esq.
Baker, Mills & Glast
500 LTV Center
2001 Ross Avenue
Dallas, Texas 75201-2916

David M. Simon, Esq.
Spensley, Horn, Jubas
& Lubitz
1800 Century Park East
Suite 500
Los Angeles, California 90067

Howard P. Brody, Esq.
Grossman, Graven, Perry
& Block
523 West Sixth Street
Suite 1130
Los Angeles, California 90014

Anthonly de Alcuaz, Esq.
Susan E. Hollander, Esq.
Skjerven, Morrill, MacPherson,
Franklin & Friel
3600 Pruneridge, Suite 100
Santa Clara, California 95051

Joseph H. Golant, Esq.
Thomas D. Phillips, Esq.
Romney, Golant, Martin &
Ashen
10920 Wilshire Boulevard
Suite 1000
Los Angeles, California 90024

Robert A. Schroeder, Esq.
Craig S. Summers, Esq.
Pretty, Schroeder,
Brueggemann & Clark
444 South Flower Street
Suite 2000
Los Angeles, California 90071

John M. Calimafde, Esq.
Marvin N. Gordon, Esq.
Hopgood, Calimafde, Kalil
Blaustein & Judlowe
60 East 42nd Street
New York, New York 10165

Kristin M. Cano, Esq.
One Newport Plaza
Suite 550
Newport Beach, California
92660

Joseph C. Sullivan, Esq.
Kane, Dalsimer, Kane, &
Sullivan & Kurucz
711 Third Avenue
New York, New York 10017

Allen M. Katz, Esq.
Jeffrey I. Weinberger, Esq.
Munger, Tolles & Olson
355 South Flower Street
Fifth Floor
Los Angeles, California 90071

Michael T. McLemore, Esq.
Arnold, White & Durkee
2300 American Center
600 Congress Avenue
Austin, Texas 78701

Richard D. Fybel
Adrian M. Pruetz
Morrison & Foerster
333 South Grand Avenue
38th Floor
Los Angeles, California 90071

Karl A. Limbach
Gerald T. Sekimura
Limbach, Limbach & Sutton
2001 Ferry Building
San Francisco, California 94111

Solicitor General
of the United States
10th & Constitution Ave. NW
Washington, DC 20001

I certify under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Executed on September 16, 1988 at 2021 L Street, Washington, D.C.

/s/ SHEHNAZ A. UNWALLA

SHEHNAZ A. UNWALLA